

### REMARKS

Claims 11-22 and 34-35 are pending in the application. Applicant thanks the Examiner for indicating that claims 18-22 are allowed.

Reconsideration and allowance of all claims are respectfully requested in view of the following remarks.

Claims 11-17 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Lindblom* (U.S. Patent No. 5,373,902) in view of *Juncker et al.* (U.S. Patent Publication No. 20020130552). Applicant respectfully traverses the rejection.

#### **I Remarks Previously Submitted**

The claimed soil stabilizer improves over conventional oil stabilizers by uniquely providing a structure that greatly reduces bounce, which in a conventional soil stabilizer causes a rotor to be moved up and down and cut at varying depths. The claimed structure also greatly reduces wiggle and slide, which in a conventional soil stabilizer cause additional bounce, inability to move in a desired direction, and loss of control.

There would have been no motivation to have combined the *Lindblom* disclosure with the *Juncker '552* disclosure, since neither reference would have taught or suggested the improved soil stabilization operation effected by the claimed apparatus. A hypothetical artisan viewing the applied references would not have expected a problem to have existed that required an improved soil stabilization operation and structure. See, e.g., *In re Nomiya*, 184 USPQ 607 (CCPA 1975). Specifically, the structure and operation of *Lindblom* perpetuate the conventional problems where: a) differences in compression between adjacent areas create ruts that in turn cause a soil stabilizer rotor to bounce and to have an inconsistent soil cutting depth; b) poor traction of the soil stabilizer also causes bounce and uneven rotor cutting depth; c) sliding on hillsides and

potential rollover accidents are caused by poor lateral traction and by a too-high center-of-gravity of a conventional soil stabilizer; and d) a compaction of earth in the direction of travel is aggravated in wet areas and a resistance to holes or floatation is poor (e.g., Applicant's specification, at page 1: line 30 to page 3: line 5).

Instead, the problem addressed by *Lindblom* relates to improving the accessibility of the rotor for servicing and maintenance (e.g., *Lindblom*, at col. 1: lines 44-57). The *Lindblom* reference is silent regarding any of the above-noted problems, and is silent regarding any associated structural limitations in Applicant's claims 11-17. Similarly, the problem addressed by *Juncker '552* relates to a conventional lack of supporting structure for track lugs, which causes excessive drive force to be imparted on the track lugs by the drive wheel, resulting in cracking and premature wear of the track lugs (e.g., *Juncker '552*, at ¶6). As noted in the *In re Nomiya* case, if there is no evidence that a person of ordinary skill in the art at the time of an applicant's invention would have expected a problem to exist at all, it is not proper to conclude that an invention which solves this problem would have been obvious to that hypothetical person. *In re Nomiya*, supra, at 612-613. "The significance of evidence that a problem was known in the prior art is, of course, that knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution." *Id.*, at 613.

In our case, the ground of rejection states, "However, Juncker discloses a soil stabilizer moved and supported by a track apparatus [,] the details of which are set forth below. It would have been obvious to one having ordinary skill in the art to provide the soil stabilizer of the Lindblom patent with the track apparatus of the Juncker patent in order to reduce the ground pressure and increase the traction of Lindblom's soil stabilizer." (Office action, at page 3). Applicant respectfully submits that the just-quoted characterization of *Juncker '552* is wrong because *Juncker '552* does not teach or suggest a soil stabilizer, at all. In addition, neither applied reference teaches or suggests any "reducing of the ground pressure" or "increasing of the

traction of" any soil stabilizer. [*Applicant notes that such expressions are those of the Examiner, not the Applicant*] Thus, there would have been no motivation or suggestion to have modified the references as posited by the Examiner. The Examiner's statement of alleged motivation can only have been gleaned from Applicants' disclosure, which amounts to impermissible hindsight. MPEP § 2143 *et seq.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *Id.*, citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Since the Examiner has not provided any support for the alleged motivation, the ground of rejection does not meet the requirements of a *prima facie* case. *Id.* Accordingly, Applicant respectfully requests the § 103 rejection of claims 11-17 be withdrawn. Claims 12-17 are patentable at least by virtue of their respective dependencies from independent claim 11.

Newly added claims 34-35 are patentable for the same reasons as just discussed for claims 11-17. See, e.g., *In re Nomiya*, *supra*.

## II Reply to "Response to Arguments"

In response to Applicant's previous arguments for the patentability of subject claims 11-17 and 34-35, repeated above, the Examiner points to the *Juncker* (US 2002/0130552) disclosure at:

- 1) ¶4, lines 5-7 and 8-10 ("Therefore, it is highly desirable to develop a track apparatus for vehicles which disbursts vehicle weight over a larger area so as to reduce the degree the ground compaction. Providing a larger ground-surface engagement area also serves to prevent vehicles from becoming bogged down in mud or other soft ground surfaces.")
- 2) ¶35, lines 4-7 ("In a preferred embodiment, track apparatus 10 is mounted on an axle (not shown) of an agricultural vehicle (e.g., a tractor or a combine), a construction vehicle or other work vehicle. It is within the scope of the present invention for track apparatus 10 to be mounted on a wide variety of vehicles.")

The Examiner takes the position (i.e., Office action, at pages 8-9) that the *Juncker* ¶4 disclosure amounts to "reducing of the ground pressure" or "increasing the traction of" a soil stabilizer. Applicant respectfully disagrees because the *Juncker* ¶4 disclosure does not teach or suggest a soil stabilizer but, instead, merely discloses that a track provides larger ground-surface engagement area compared with the small tire area in contact with the ground. Applicant respectfully submits that such properties of tracks, generally, are known, but that this general knowledge does not constitute any teaching or suggestion of the claimed soil stabilizer as a whole.

The Examiner also takes the position (i.e., Office action, at page 9) that the *Juncker* ¶35 disclosure amounts to a "soil-engaging track apparatus for use on 'an agricultural vehicle . . . a construction vehicle or other work vehicle'." Applicant respectfully submits that this *Juncker* ¶35 statement falls well short of teaching or suggesting the claimed soil stabilizer as a whole.

Applicant respectfully points out that "a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is *part* of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103. . . . The issue, then, is whether the teachings of the prior art would, *in and of themselves and without the benefits of appellant's disclosure*, make the invention as a whole, obvious." *In re Nomiya, supra*, at 612, quoting *In re Sponnoble*, 160 USPQ 237, 243 (CCPA 1969)(emphasis in original), additional citations omitted. In our case, the present inventor has determined that several above-identified problems particular to the operation of a soil stabilizer (e.g., Applicant's specification, at page 1, line 15 to page 3, line 9) are remedied by the claimed invention as a whole (emphases added).

At best, the applied references disclose an improved hood assembly that allows service access (*Lindblom*, e.g., Abstract) and an improved drive wheel for a track apparatus that

Amendment under 37 C.F.R. § 1.116  
U.S. Application Serial Number 10/730,574

minimizes shearing forces and excessive torque on a track by adjusting precise positions of engagement with lug-engagement surfaces (*Juncker*, e.g., Abstract, ¶8). Such falls well below any suggestion or motivation of the claimed combination, especially because the claimed invention solves problems propagated by conventional apparatus such as those disclosed in *Lindblom*. Since there would have been no suggestion or motivation to have modified the applied references, Applicant respectfully requests the § 103 rejection of claims 11-17 and 34-35 be withdrawn.

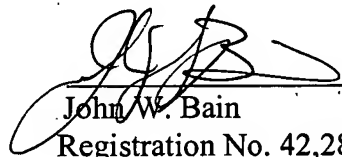
#### **Request for Interview**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly **requested to call** the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 10-0270.

Respectfully submitted,

Jansson, Shupe, Munger & Antaramian, Ltd.  
245 Main Street  
Racine, WI 53403  
Telephone: (262) 632-6900  
Facsimile: (262) 632-2257

  
John W. Bain  
Registration No. 42,283

Date: **May 2, 2006**